

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P. O. Box 7599
Loveland, Colorado 80537-0599

ATTORNEY DOCKET NO. 10991398-1

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DEC 22 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Diane D. Ilsey

Serial No.: 09/919,643

Examiner: Betty J. Forman

Filing Date: July 31, 2001

Group Art Unit: 1834

Title: Methods for Depositing Small Volumes of Protein Fluids onto a Surface of a Substrate

COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- ☐ Response/Amendment ☐ Petition to extend time to respond
☐ New fee as calculated below ☐ Supplemental Declaration
☒ No additional fee (Address envelope to "Mail Stop Amendments")
☒ Other: Response to Restriction Requirement dated 11/22/05 (Fee \$_____)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X 50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X 200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ 380	\$ 0
EXTENSION FEE	1 ST MONTH 120.00 <input type="checkbox"/>	2 ND MONTH 450.00 <input type="checkbox"/>	3 RD MONTH 1020.00 <input type="checkbox"/>	4 TH MONTH 1590.00 <input type="checkbox"/>		\$ 0
OTHER FEES						\$ 0
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Diane D. Ilsey

By

Bret E. Field for Dianne Rees
Attorney/Agent for Applicant(s)

I hereby certify that this paper is being facsimile
transmitted to the Patent and Trademark Office on
the date shown below: (571) 273-8300

Date of facsimile: 12-22-2005

Typed Name: Martha Cisneros

Signature: 

Reg. No. 37,620

Date: 12-22-2005

Telephone No. (650) 485-5999

Rev 06/05 (TransAmd)

VIA FACSIMILE 571-273-8300		
RESPONSE TO RESTRICTION REQUIREMENT Address to: Commissioner for Patents P.O. Box 1450 Alexandria VA 22313-1450	Attorney Docket Confirmation No.	10991398-1 5729
	First Named Inventor	Diane D. Hsley
	Application Number	09/919,643
	Filing Date	July 31, 2001
	Group Art Unit	1634
	Examiner Name	Betty J. Forman
	Title	Methods for Depositing Small Volumes of Protein Fluids onto a Surface of a Substrate

Dear Sir:

This communication is responsive to the office communication dated November 22, 2005.

In the above referenced office communication, the Examiner imposed a restriction requirement, requiring the election of the claims of either:

Group I, i.e., Claims 1-28;
Group II, i.e., Claims 29, 30 and 34; or
Group III, i.e., Claims 31-33;
for further prosecution in this application.

The Applicants hereby elect Group I with traverse.

The Applicants also respectfully urge the Examiner to rejoin the claims of Groups II and III with the elected claims of Group I for examination in this application for the following reasons.

The MPEP allows an Examiner to examine otherwise patentably distinct sets of claims if to so would not impose an undue burden on the Examiner. M.P.E.P. § 8.03 states that:

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United States Application Serial No. 09/919,643

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

In the present case, the claims of Groups II and III are directed to articles and use thereof of the product of the methods of Group I. As such, the search for the claims of Group I will find any relevant prior art relating to the claims of Groups II and III.

Accordingly, little, if any, additional searching should be required for the claims of Groups II and III, and therefore the examination of the claims of Groups II and III together with the claims of elected Group I should impose little, if any, additional burden on the Examiner.

As such, examining the claims of Groups II and III and the claims of elected Group I together in the present application clearly does not impose an undue or serious burden on the Examiner. In the absence of such an undue or serious burden, the Examiner is clearly instructed by the MPEP to examine the entire application. Therefore, the Examiner is respectfully requested to rejoin the claims of Groups II and III with the claims of elected Group I and to examine all the claims together in the present application.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

Date: December 22, 2005

By: 

Bret E. Field
Registration No. 37,620

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